

REMARKS

Claims 1-23 were filed in the original application. Claim 24 was added in the amendment mailed on April 19, 2004. Claims 25-30 are added herein. Support for these new claims is found throughout the specification, *e.g.*, at pages 48-56 and 92-97.

Claim Rejections

Claim 1 was rejected under 35 U.S.C. §102(e). Claims 5, 6, 20, 22 and 24 were rejected under 35 U.S.C. §103(a).

I. Rejections under 35 U.S.C. §102(e)

A. Claim 1 Is Not Anticipated By Levin

The Examiner rejects Claim 1 as being anticipated by U.S. Patent 6,432,365 (hereinafter “Levin”) under 35 U.S.C. §102(e). Office Action, page 2. The Applicants respectfully disagree. However, in order to expedite prosecution, claim 1 is now amended to comprise a lid enclosure comprising a ventilation system. The Specification provides ample support for this amendment. (See, *e.g.*, Specification, page 50, lines 18-20).

In the device of Levin, the ventilation port in the device cover and the lid for accessing the reaction chamber are separated into distinct elements and cannot be combined without destroying the intended function of the invention of Levin. For example, the Specification of Levin, at Column 8, lines 24-29, recites:

Centrifuge chamber **112** must be sufficiently sealed so that it is capable of maintaining a vacuum and resistant to the harsh chemicals used during processing of the samples. Chamber lid **116** provides access to the interior of chamber **112** for loading and unloading of the sample and collection containers.

The ventilation port of Levin is separated from the chamber lid because combination of these two elements would go against the stated requirement that the chamber of the Levin device be sufficiently sealed so that it is capable of maintaining a vacuum within the centrifuge chamber.

In the instant invention, the lid enclosure covering the reaction chamber is the same lid enclosure comprising a ventilation system that provides the substantially ventilated workspace. (See, *e.g.* Figure 19C). As such, Claim 1 as presently amended is not anticipated by Levin. The

Levin apparatus lacks the element of Claim 1 wherein the lid enclosure itself comprises the ventilation system that provides a substantially ventilated workspace. The Applicants request this rejection be withdrawn.

II. Rejections under 35 U.S.C. §103(a)

The Examiner rejects Claims 5, 6, 20, 22 and 24 under 35 U.S.C. §103(a). Office Action, pages 3-4. The Applicants respectfully disagree. A *prima facie* case of obviousness requires first, a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. MPEP §2143. As discussed in detail below, the Examiner fails to present a *prima facie* case of obviousness.

A. Claims 5 and 6 Are Non-Obvious

The Examiner rejects Claims 5 and 6 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,432,364 (hereinafter “Levin”). Office Action, pages 3-4. However, as described in detail above, Claim 1 as amended is not anticipated by Levin. Therefore, the prior art reference does not teach or suggest all the claim limitations as is required for a demonstration of *prima facie* obviousness. MPEP §2143.01. As such, the Applicants request this rejection be withdrawn.

B. Claims 20, 22 and 24 Are Non-Obvious

The Examiner rejects Claims 20, 22 and 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,238,627 (hereinafter “McGowan”) in view of U.S. Patent 6,264,891 (hereinafter “Heyneker”). The Applicants respectfully disagree. However, in order to expedite prosecution, claim 20 is now further amended to comprise a vacuum source connected to the ventilation opening in the top enclosure.

A *prima facie* case of obviousness requires that “the prior art reference must teach or suggest all the claim limitations.” MPEP §2143.03. Neither the McGowan or the Heyneker inventions contain the vacuum-ventilation system of the instant invention. As the Examiner has stated, “The system of Heyneker includes a vacuum system that is used to drain fluids from the bottom of the reaction vessels.” Office Action page 5. In Claim 20 as amended, the vacuum source of the instant invention is connected to the ventilation port in the top enclosure, and

therefore cannot serve the purpose of draining fluids from the reaction vessels as is required by the vacuum system of Heyneker. Indeed, the Examiner has argued that the “the addition of the teachings of Heyneker becomes relevant” because “McGowan does not provide any element for removing the fluids from the reaction containers.” The Applicants submit that the McGowan and Heyneker references cited by the examiner in framing this rejection do not teach or suggest all the claim limitations of the instant invention. Therefore, no *prima facie* case of obviousness has been established. As such, the Applicants request this rejection be withdrawn.

Furthermore, a *prima facie* case of obviousness requires “a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.” MPEP §2143.01. The Examiner has provided no argument as to the suggestion or motivation for the addition of the vacuum drain system of Heyneker to the reaction block of McGowan. As stated in the MPEP, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless prior art also suggests the desirability of the combination.” MPEP §2143.01. Furthermore, “the level of ordinary skill in the art cannot be relied upon to provide the suggestion to combine references.” *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). In the absence of a prior art reference containing a suggestion or motivation for combination, Applicants submit the Examiner has not met the requirements for establishing a case of *prima facie* obviousness. As such, Applicants respectfully request this rejection be withdrawn.

New Claims

New dependent claims have been added that are supported by the specification. (See, e.g., Specification at pages 48-56 and 92-97). These new method claims contain additional elements, supported by the specification, that further make plain the inventive quality of the instant apparatus and methods of using it. The prior art of record does not teach these methods. In particular, the prior art of record, as noted in previous argument by the Applicants, does not teach methods for providing a ventilated workspace for use with an oligonucleotide synthesizer by providing an oligonucleotide synthesizer comprising a lid enclosure comprising a ventilation system. As such, Applicants respectfully request these new claims be passed to allowance forthwith.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants have addressed all grounds for rejection and Applicants' claims as amended should be passed to allowance. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicant encourages the Examiner to call the undersigned collect at 608-218-6900.

Dated: December 14, 2004



Mary Ann D. Brow
Registration No. 42,363

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
(608) 218-6900